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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,097	11/17/2003	Virginijus Bumeikis	50087-0001	3256

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EXAMINER
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POUS, NATALIE R

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/715,097

Applicant(s)

BURNEIKIS, VIRGINIJUS

Examiner

Natalie Pous

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 17-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 and 26 is/are rejected.
- 7) ☒ Claim(s) 14-16 and 27-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/03/03, 3/31/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of claims 11-16 and 18-31 in the reply filed on 3/16/06 is acknowledged. The traversal is on the ground(s) that the product and process of use are not patentably distinct. This is not found persuasive because of the following:

Applicant contends that product and process of use are not patentably distinct in that they are in the same stated classes and subclasses. Examiner asserts that a restriction requirement is proper if the two inventions have acquired a separate status in the art because of their recognized divergent subject matter, not necessarily dependent on different classification. However in light of further consideration of the application, examiner asserts the following as the proper classifications:

1. Claims 1-9 and 17-25 drawn to apparatus, classified in class 606, subclass 1
2. Claims 11-16 and 18-31 drawn to method of using, classified in class 600, subclass 37.

As such, not only have the inventions acquired a separate status in the art in view of their different classification, but the inventions require a different field of search (see MPEP § 808.02), and they have acquired a separate status in the art because of their recognized divergent subject matter, thus restriction for examination purposes as indicated is proper.

Next, applicant asserts that the apparatus claims relate to a tubular member with a plunger slidably received within the tubular member. Examiner points

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out that the broadest claim is claim 1, which requires the vessel, but not the plunger. As the restriction is based on the broadest claim, examiner asserts that the device as claimed can be used in a materially different process other than that disclosed in the method claims. Applicant states that the assertion that the device may be used in a different process is "the wrong criteria for restriction," however, examiner holds that inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case as described in the restriction requirement, the device as claimed and described in the specification can be used in a number of materially different process other than that disclosed in the process claims, including but not limited to, a port for inserting surgical tools into the body or a support for another portion of the body.

Next, applicant asserts that the application does not disclose two or more independent or distinct inventions, citing MPEP (802.01) and further states that the restriction is inappropriate in that the claims are classified in the same class and subclass. This point is moot in based on the reclassification above, however examiner notes that even if two inventions are classified in the same class and subclass it does not mean that the search is the same or coextensive. Examiner further draws applicants attention to MPEP (802.01) regarding the meaning of "independent and distinct inventions:"

*"The term "independent" as already pointed out, means not dependent. A large number of >inventions< between which, prior to the 1952 Act, division had been proper, are dependent >inventions<, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the >Director< never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the >Director< has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent."*

Examiner asserts that based on the previous explanations, the two inventions are in fact distinct, and thus may be properly restricted.

Regarding the claim that the art disclosed in the interview has nothing to do with the invention claimed in the instant application, examiner notes that art anticipating

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claims need not be analogous, however substantive issue regarding claim objections or rejections will not be addressed in the response to this traversal.

Finally regarding the applicants assertion that the filing of divisional applications and thus creating a number of file histories directed to related claims may result in lost of allowable patent rights, examiner reminds applicant that an applicant is only entitled to a single patent for a single invention.

Based on the explanation above, the requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

The disclosure is objected to because of the following informalities:

page 13, paragraph 42 recites "tubular element 12" in line 3, and "tubular element 100" in line 4, it is inferred that the correct language for line 4 is --device 100--.

Page 13, paragraph 42 calls for "a circular guide plate 240 on the other" it is inferred that the correct language is --a circular guide plate 242 on the other.--

Page 16, paragraph 50 says "umbiliplasty," it is inferred that the correct spelling is --umbilicoplasty--

Appropriate correction is required.

### ***Drawings***

The drawings are objected to because figure 2 includes reference character 118, referring in the specification to "circular lip" comprising notches 122 and 124 (page 13, par. 42), however figure 2 is missing character "122" and it appears that character 118 is pointing to a notch. Corrected drawing sheets in compliance with 37 CFR 1.121(d)

are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 recites the limitation "the notches" in line 6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoeller et al. in view of Kohl (US 2973761).

Schoeller teaches a method of abdominal surgery comprising circum dissecting the umbilicus, but does not teach wherein the umbilicus is protected by being enveloped within an open ended vessel. Kohl teaches an open-ended tubular element (10a) for drawing in an umbilical pedicle (u) into the interior of the vessel (fig. 6) in order to protect the umbilicus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Schoeller with the open ended vessel of Kohl in order to protect the umbilicus from damage.

***Allowable Subject Matter***

Claims 14-16 and 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie Pous whose telephone number is (571) 272-6140. The examiner can normally be reached on Monday-Friday 8:00am-5:30pm, off every 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NRP  
5/25/06

  
(JACKIE) TAN-UYEN HO  
PRIMARY EXAMINER  
5/30/06